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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,541	03/31/2004	William D. Goldberg	RSW920040016US1	7408

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MARCIA L. DOUBET LAW FIRM  
PO BOX 422859  
KISSIMMEE, FL 34742

EXAMINER
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ANDERSON, FOLASHADE

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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07/22/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/814,541	<b>Applicant(s)</b> GOLDBERG ET AL.	
	<b>Examiner</b> FOLASHADE ANDERSON	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-21 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-21 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the first non-final office action in response to Applicant's submission filed on 03/31/2009. Currently, claims 18-21 and 28 are pending. Claims 1-17 and 22-27 are canceled.

#### ***Election/Restrictions***

2. Applicant's election without traverse of group II (claims 18-21 and 28) in the reply filed on 03/31/2009 is acknowledged.

#### ***Information Disclosure Statement***

3. It is noted that Applicant submitted no information disclosure statement (IDS) for consideration by the Examiner in the prosecution of the claims of the instant application under 37 CFR 1.56.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for a method to be considered a "process" under §101, a claimed process must either comply with the "machine-or-transformation test" (1) be tied to a particular

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machine or apparatus *or* (2) transform a particular article to a different state or thing. *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to independent claim 18, the claim language recites the steps of determining, developing, performing, programmatically computing, assigning, etc.; however the claim language does not include the required tie or transformation.

Claims 19-21 are rejected based upon the same rationale, wherein the claim language does not include the required tie or transformation.

Further it is noted that the claim language of “programmatically computing” and “programmatically select” is ambiguously directed towards software per se and does not satisfy the requirements of the “machine-or-transformation test”.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (US Patent 6,895,382 B1).

**Claim 18** Srinivasan teaches a method of determining resource placement (abstract), comprising:

- determining a set of business objectives for one or more candidate locations (Srinivasan col.2, lines 21-24, col. 11, lines 29-48 and table 2, col. 11 and 12);
- developing one or more objective measurements for each business objective (Srinivasan col. 6, lines 17-48)
- performing value chain analyses related to the set of business objectives, thereby determining what types of resources will potentially improve the analyzed value chain (Srinivasan tables 1-3);
- developing cost factors pertaining to placing the determined resources in the candidate locations (Srinivasan chart 1.3 rates, col. 26 and chart 1.4 staff transition matrix, col. 29-32 showing the delta of current cost, in-house cost and outsourced cost) ;
- programmatically computing a value using the business objectives, according to the developed objective measurements, and the developed cost factors, and using the programmatically-computed value to programmatically select a particular location from among the candidate locations; and
- assigning the determined resources to the programmatically-selected particular location.

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**Claim 20** Srinivasan teaches the method according to Claim 18, wherein the assigned resources are information technology personnel (Srinivasan col. 26, lines 1-5).

**Claim 21** Srinivasan teaches the method according to Claim 18, wherein the assigned resources comprise monetary investments in the particular location (Srinivasan skills rate table col. 26, lines 30-67).

8. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Keay et al (US Publication 2005/0065831 A1).

**Claim 28** Keay teaches a system for assigning resources, comprising:

- a computer comprising a processor (Keay 0002, 0041);
  - a set of business objectives for one or more candidate locations (Keay 0016);
  - one or more objective measurements for each business objective (Keay 0093, 0100);
  - results of value chain analyses performed related to the set of business objectives, the results usable for determining what types of resources will potentially improve the analyzed value chain (Keay figures 4A & 4B and 0095-0100);
  - cost factors pertaining to placing the determined resources in the candidate locations (Keay 0043, 0058);

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- instructions which are executable on the computer, using the processor, to implement functions comprising (Keay 0105):
  - programmatically computing a value, using the business objectives, according to the developed objective measurements, and the developed cost factors (Keay 0093, 0100); and
  - using the programmatically-computed value to programmatically select a particular location from among the candidate locations thereby enabling assignment of the determined resources for placement in the programmatically-selected particular location (Keay 0043, 0058);.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (US Patent 6,895,382) in view of Baker et al (Project Management, 2<sup>nd</sup> Edition, published 2000).

**Claim 19** Srinivasan teaches the method according to Claim 18; however Srinivasan is silent on, wherein the computing further comprises estimating and accounting for any lag time characteristics discovered while performing the value chain analyses.

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Baker teaches wherein the computing further comprises estimating and accounting for any lag time characteristics discovered while performing the value chain analyses (Baker p.113).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the invention of Srinivasan the estimating and accounting for any lag time characteristics discovered while performing the value chain analyses as taught by Baker since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Handel (Identifying and Selecting Outsource Providers, Apr./May 2000), Willcocks et al (Information Technology Outsourcing in Europe and the USA: Assessment Issues, 1995), Ngwenyama et al ( Making the information systems outsourcing decision: A transaction cost approach to analyzing outsourcing decision problems, 1999), Lin et al (A Decision model for Selecting an Offshore Outsourcing Location: Using a Multicriteria Method, 2007), and McLellan et al (Information Technology Outsourcing, 1994), teach the procedures for selecting an outsourcing provider. Lee et al (The Evolution of Outsourcing Research: What is next issue?" teaches on going research in the field of outsourcing decisions, 2000).



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Preston (Lost in migration: offshore need not mean outsourced, 2004) teaches selecting a location.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FOLASHADE ANDERSON whose telephone number is (571)270-3331. The examiner can normally be reached on Monday through Thursday 8:00 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Folashade Anderson/  
Examiner, Art Unit 3623

/Andre Boyce/  
Primary Examiner, Art Unit 3623

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